Arguments / Remarks

Claims 1-20 remain in the application, all of which stand rejected.

1. Rejection of Claims 1-20 Under 35 USC 101

Claims 1-20 stand rejected under 35 USC 101. More specifically, the Examiner asserts that none of these claims provides a useful or tangible result. Applicants disagree.

Claim 1 recites:

> Apparatus, comprising:
> computer readable media; and
> program code, stored on the computer readable media, comprising:
> code to define a user interface;
> code to detect invalid test definition data in user input and, upon detection of invalid test definition data, prompt a user to select a valid data option from a set of valid data options; said prompting being undertaken through the user interface; and
> code to receive a valid data option selected through the user interface, and to update the invalid test definition data with the valid data option.

As evidence that claim 1 does not provide a useful or tangible result, the Examiner refers to applicants' paragraph [0014], which states:

> For purposes of this description, the phrases "user input" and "test definition data" are intended to cover data that is manipulated, as well as the commands or instructions that cause the data to be manipulated. User input 102 may be provided in various forms, and may be provided in the form of a test definition file (or files), or in the form of individual responses. User input 102 may also be provided to code 100 prior to launch of the code, or interactively (and possibly through a screen of user interface 106). Test definition data is defined herein to include any sort of data that is used to configure a circuit tester, such as the names of pins, devices, nodes, and node connections to be tested, as well as the types and sequences of tests to be executed by a circuit tester.

The Examiner then asserts that, because the "user input" referenced in claim 1 may only be a "test definition file", the update of such a file with valid data does not provide a useful and tangible result. Although applicants disagree, applicants note that an update of test definition data is not the only result provided by claim 1. Another result is the prompting of a user "to select a valid data option from a set of valid data options". This result is "useful" in that it alerts the user that invalid test definition exists and gives the user an opportunity to replace the invalid test definition data with a "valid data option". Prompting a user to select a valid data option is also "tangible", because it necessarily involves conveying the "set of valid data options" to the user.

Claim 1, and dependent claims 2-13, are believed useful and tangible for at least the above reasons. Claims 14-20 are believed useful and tangible for similar reasons.

2. Rejection of Claims 1-7, 10-16, 19 and 20 Under 35 USC 103

Claims 1-7, 10-16, 19 and 20 stand rejected under 35 USC 103(a) as being unpatentable over Colby et al. (US Pat. No. 6,622,271; hereinafter "Colby") in view of Gygi et al. (US Pub. No. 2003/0235156 A1; hereinafter "Gygi").

Applicants' claim 1 recites:

> Apparatus, comprising:
> computer readable media; and
> program code, stored on the computer readable media, comprising:
> code to define a user interface;
> code to detect invalid test definition data in user input and, upon detection of invalid test definition data, prompt a user to select a valid data option from a set of valid data options; said prompting being undertaken through the user interface; and
> code to receive a valid data option selected through the user interface, and to update the invalid test definition data with the valid data option.,

With respect to applicants' claim 1, the Examiner admits that Colby does not teach, "code to. . ., upon detection of invalid test definition data, prompt a user to select a valid data option from a set of valid data options". However, the Examiner asserts that Gygi, in one or more of paragraphs [0048], [0050], [0051], [0068] or [0069] discloses "***code to detect invalid test definition data in user input and, upon detection of invalid test definition data,*** prompt a user to select a valid data option from a set of valid data option" (emphasis added). The Examiner also asserts that it would have been obvious to combine Gygi's and Colby's teachings "to assist automated testing systems through standardized user interface and programming interface for performing circuit tests." Applicants disagree.

Applicants cannot find any teaching by Gygi that invalid test definition data should be "detected", or that a user should be prompted "upon detection of invalid test definition data". As such, applicants believe Gygi lacks any sort of teaching or suggestion that would motivate one of ordinary skill in the art to incorporate Gygi's "parameter definition" interface into the interface 137 associated with Colby's interpreter program 131. On the flipside, Colby lacks any sort of teaching or suggestion that would motivate one of ordinary skill in the art to modify Colby's interpreter program 131 or rules checker program 76 to me more proactive in helping a user correct invalid test definition data.

The lack of any teaching or suggestion to combine Colby's and Gygi's teachings is likely a result of differences in Colby's and Gygi's systems. That is, Colby discloses a test system wherein an already developed "test definition" is executed, and if errors are generated during execution of the test definition, a user is given an ability to modify the test definition. *See*, e.g., Colby, col. 12, lines 3-29. Gygi's system, on the other hand, is directed more to the front-end of "test vehicle" development. As a result, it enables a test developer to provide "custom commands" and "parameter definitions" that encourage or force a test system operator to select valid test parameters *before* a test vehicle is started. *See*, e.g., Gygi, para. [0048]-[0051]. In other words, Colby's system is really a "curative" system, whereas Gygi's system is a "preventive" system. As such,

applicants do not see how one of ordinary skill in the art would have been motivated to combine their teachings, and applicants do not believe the invention recited in their claim 1 would have been obvious to one of ordinary skill in the art.

Claim 1 is believed allowable for the above reasons. Claims 2-13 are believed allowable, at least, because they depend from claim 1. Claims 14-20 are believed allowable, at least, for reasons similar to why claim 1 is believed allowable.

Claims 2-5 and 16 are also believed allowable over the combined teachings of Colby and Gygi for additional reasons, as set forth below.

Claim 2, from which claims 3-5 depend, recites:

> The apparatus of claim 1, wherein the program code further comprises code to compile the set of valid data options based on a context of the invalid test definition data.

With respect to applicants' claim 2, the Examiner asserts that Gygi teaches "code to compile the set of valid data options based on a context of the invalid test definition data", in one or more of paragraphs [0048], [0050], [0051], [0068] or [0069]. Applicants have reviewed these paragraphs and can find no such teaching. If the Examiner believes the teaching is there, applicants ask that the Examiner more specifically explain where the teaching is found.

Claim 16 is believed allowable for reasons similar to why claim 2 is believed allowable.

3. Allowable Claims

Applicants appreciate the Examiner's indication that claims 8, 9, 17 and 18 are allowable but for their dependence upon a rejected base claim. However, applicants prefer to leave these claims in their current form until the Examiner has considered the above remarks and arguments.

4. Conclusion

In summary, the art of record does not teach nor suggest the subject matter of applicants' claims 1-20. These claims are therefore believed to be allowable.

Respectfully submitted,
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